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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,631	03/18/2004	Blaine H. Dolph	AUS920040046US1	5810
35525	7590	02/24/2009		
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EXAMINER				
TEKLE, DANIEL T				
ART UNIT		PAPER NUMBER		
2621				
NOTIFICATION DATE		DELIVERY MODE		
02/24/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

# Office Action Summary

**Application No.**

10/803,631

**Applicant(s)**

DOLPH, BLAINE H.

**Examiner**

DANIEL TEKLE

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) **1-11** is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions<sup>2</sup> indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. The method of modifying a marketing steps, which listed in the claims, are not tied to the device that performs the editing process.

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-23 are rejected under 35 U.S.C. 102(B) as being anticipated by  
Freeman et al (US 2001/0013123).

**Regarding Claim 1:** Freeman et al discloses a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising: receiving a television program containing an original marketing from a service provider (**paragraph 0027**); storing the television program in the memory (**paragraph 0072**); sending a user ID and a program ID to the service provider to cause a local marketing content (**paragraph 0031**), based upon the user ID and the program ID, to be sent to the DVR; (**paragraph 0090**); determining whether a local marketing content has been received at the DVR(**paragraph 0064**); responsive to the determination that the local marketing content has been received at the DVR (**paragraph 0064**), creating a modified marketing by modifying the original marketing with the local marketing content (**paragraph 0090**); and displaying the television program with the modified marketing upon a user request (**paragraph 0090 and fig. 1a element 110**).

**Regarding Claim 2:** Freeman et al discloses a method of claim 1 further comprising: determining whether a message indicating that no local marketing content exists for the television program has been received (**paragraph 0033**); and responsive to the determination that the message indicating that no local marketing content exists for the

television program has been received, displaying the television program with the original marketing upon the user request (**paragraph 0033 and fig. 1a element 110**).

**Regarding Claim 3:** Freeman et al discloses a method of claim 2 further comprising: responsive to the determination that the local marketing content has been received (**paragraph 0064 and 0073**), determining whether the local marketing content is add-on marketing (**paragraph 0073**); and responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing (**paragraph 0090**).

**Regarding Claim 4:** Freeman et al discloses a method of claim 3 further comprising: responsive to the determination that a local marketing content has been received, determining whether the local marketing content is replacement marketing (**paragraph 0090**); and responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing (**paragraph 0090**).

**Regarding Claim 5:** Freeman et al discloses a method of claim 4 further comprising: responsive to the determination that a local marketing content has been received, determining whether the local marketing content is overlay marketing (**paragraph 0073 and 90**); and responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing (**paragraph 0073 and 0090**).

**Regarding Claim 6:** Freeman et al discloses a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising: receiving a user ID and a program ID (**paragraph 0049**); determining the location of a user based on the user ID (**paragraph 0049**); determining whether a local marketing content exists for a television program based on the program ID (**paragraph 0073 and 0083**); and responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR (**paragraph 0073**).

**Regarding Claims 7, 9-11:** Claims 7 and 9-11 are rejected for the same subject matter as claims 2-5 respectively.

**Regarding Claim 8:** Freeman et al discloses a method of claim 7 wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile (**paragraph 0049**).

**Regarding Claims 12-22:** Claims 12-22 are rejected for the same subject matter as claims 1-11 respectively.

**Regarding Claims 23:** Claims 23 is rejected for the same subject matter as claims 1-11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/  
Supervisory Patent Examiner, Art Unit 2621

/Daniel Tekle/  
Examiner, Art Unit 2621